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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,781	06/29/2001	Marcus Peinado	MSFT-0264/148578.1	8894

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EXAMINER

PORTKA, GARY J

ART UNIT PAPER NUMBER

2188

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,781

Applicant(s)

PEINADO, MARCUS

Examiner

Gary J. Portka

Art Unit

2188

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 8, 2005 has been entered.
2. Claims 1, 11, and 16 have been amended, and claims 8 and 13-15 have been canceled by Applicant. Claims 1-7, 9-12, and 16-18 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 9-12, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakagawa, US 4,860,128.
5. As to claim 1, Nakagawa discloses a *method that determines if a device is trustworthy based upon a proprietary hardware interface between the processing device (FDD 20) and a portable memory recording device (floppy disk 10) (see Abstract, Figs. 1, 2A-C, 7, and 8A-B, col. 1 lines 13-15 and 57-59, col. 1 line 63 to col. 2 line 39, col. 3 lines 38-45, col. 5 lines 48-66, col. 6 lines 20-53, col. 7 line 56 to col. 8 line 27; the*

interface includes head 27, plus sensor 32 or load detection at 58/60), *and using the device to record protected content onto a portable memory* (magnetic disk 12). *The system* (Fig. 1) *receives or has received data, this data is protected* as claimed since the system will not be able to access the portable device (i.e., floppy) if it does not interface properly.

6. As to claims 2-5, 11-12, and 18, in addition to as discussed above with regard to claim 1, Nakagawa discloses determining not recording outside of a class, the class being floppies that run on that system; also, memory not readable by device lacking the capability of interfacing with the system.

7. As to claims 6-7, 9, and 16-17, in addition to as discussed above with regard to claim 1, Nakagawa discloses the limited copying (inherent in the interfacing requirement for the system) feature is proprietary and licensed (since it is patented, inherently proprietary and capable of being licensed).

8. Claims 1-7, 9-12, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Olarig et al., US 6,032,257.

9. As to claim 1, Olarig discloses a *method that determines if a device is trustworthy based upon a proprietary hardware interface between the processing device and a portable memory recording device* (see Abstract, col. 3 lines 18-34, col. 4 lines 4-7 and 57-61, col. 5 lines 38-55, and col. 6 lines 6-17 and 28-41; based on the hardware interface since first a device is detected during a bus discovery phase and a non-vendor device may be indicated as unauthorized, and second hardware components are encoded to perform a digitally authenticated handshake which passes checks and

responses – both first and second steps use and require the correct interface). *The system* (i.e., 120, Fig. 3) *receives or has received data, this data is protected* as claimed since the system will not be able to access the portable device (i.e., floppy) if it does not authenticate properly.

10. As to claims 2-5, 11-12, and 18, in addition to as discussed above with regard to claim 1, Olarig discloses determining not recording outside of a class, the class being memories that run on that authorized system; also, memory not readable by device lacking the capability of interfacing the correct handshake signals.

11. As to claims 6-7, 9, and 16-17, in addition to as discussed above with regard to claim 1, Olarig discloses the limited copying (inherent in authentication requirement for the system) feature is proprietary (“vendor-specific hardware”), and licensed (clearly the recited permitting is obtained for a manufacturer to make such a device, and such a manufacturer is bound by the operational specifications and thus rule governing usage as meant by the term license).

12. Claims 1-7, 9-12, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano et al., US 5,778,421.

13. As to claim 1, Nagano discloses *a method of recording data comprising receiving protected content at a processing device* (information processor, 10, 20, 30, see Abstract, Fig. 2), *determining that a portable memory recording device* (40) *is trustworthy based on a proprietary hardware interface between the processing device and the recording device* (see col. 1 lines 13-21, col. 2 line 47 to col. 3 line 27, col. 4 lines 44-67, col. 5 lines 33-50, col. 6 lines 65-67, col. 7 lines 1-35, and col. 7 line 48 to

col. 8 line 13; based on the interface since the CD 41 must store proper name which is indicated via the interface, also, because the validation requires the contacters 26, 47), and *using the recording device to record the content onto a portable memory* (note the Abstract mentions magnetic disks and DVD-RAM, and thus the system pertains to recording as well as reading).

14. As to claims 2-5, 11-12, and 18, in addition to as discussed above with regard to claim 1, Nagano discloses *determining not recording outside of a class*, the class being memories that run on that authorized system; also, memory not readable by device lacking the capability of interfacing the correct security signals.

15. As to claims 6-7, 9 and 16-17, in addition to as discussed above with regard to claim 1, Nagano discloses the limited copying (inherent in authentication requirement for the system) feature is proprietary (the entire system is protected by patent), and licensed (where the use of the invented security circuit and identifications is considered permitted by license, and such a user is bound by the operational specifications and thus rule governing usage as meant by the term license).

Response to Arguments

16. Applicant's arguments filed July 8, 2005 have been fully considered but they are not persuasive. Applicants argue that Olarig does not use a proprietary interface, and that if one were used there would be no need to verify authenticity codes. However, the authenticity codes are considered by the examiner to be a part of the interface, which must be proprietary (exclusively owned or private) to be effective. Applicants also argue that Nagano does not teach a proprietary interface, citing that it uses as an example

DVD-RAMS. However, the interface includes the circuits previously cited and shown in Fig. 2, and these are proprietary because they are at least in part protected by the patent claims.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary J. Portka whose telephone number is (571) 272-4211. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (571) 272-4210. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary J Portka
Primary Examiner
Art Unit 2188

September 19, 2005

**GARY PORTKA
PRIMARY EXAMINER**